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OFFICE OF PETITIONS

In re Application of
Stockwell et al.
Application No. 09/611,835
Filed: 07/07/2000
Attorney Docket No. 50164/002002

DECISION ON PETITION

This is a decision on the "PETITION TO WITHDRAW NOTICE OF ABANDONMENT AND ISSUE NOTICE OF ALLOWANCE UNDER 37 C.F.R. § 1.181," filed March 7, 2008.

On September 23, 2005 (certificate of mailing September 21, 2005) petitioners filed a notice of appeal to the final Office action of March 21, 2005, in which claims 89-156 stood rejected under 35 U.S.C. § 103 as being unpatentable over Stylli et al. (US Patent 5,985,214). Additionally, petitioners submitted a request for an extension of time for response within the third month and a Pre-Appeal Brief Request for Review. The rejection under 35 U.S.C. § 103 was maintained in the Pre-Appeal Brief Review. On March 15, 2006, petitioners submitted a request for an extension of time for response within the third month and an appeal brief seeking reversal of the rejection. On April 20, 2007, the Board of Patent Appeals and Interference ("Board") reversed the examiner's rejection, but set forth new grounds of rejection of claims 89-156. The Board set a period of two months from the date of the decision for the petitioners to either reopen prosecution or request a rehearing. On June 25, 2007 (certificate of mailing dated June 20, 2007), petitioners filed a request for rehearing seeking withdrawal of the new grounds of rejection of the claims. On November 20, 2007, the Board granted the request for rehearing with respect to claims 154-156, withdrawing its new ground of rejections of claims 154-156, while maintaining its rejection of the remaining claims. On February 5, 2008, the examiner conducted a telephone interview at which time petitioners stated that they confirmed that they did not intend to appeal from the Board's Decision on Rehearing. On February 11, 2008, the Office mailed a Notice of Abandonment, indicating that the application became abandoned for failure to timely reply to the Office letter of November 20, 2007. On March 7, 2008, petitioner filed the present petition to withdraw the holding of abandonment.

Petitioners assert that the USPTO erred in issuing a Notice of Abandonment in this application. Petitioners request that the Office withdraw the holding of abandonment in the above-identified application, and to issue a Notice of Allowance, stating that claims 154-156 stand allowed, pursuant to the Decision on Rehearing of the Board mailed November 20, 2007. Petitioners aver that when claims are found allowable by the Board, an applicant is not required to file a reply to the Board's

Decision. Petitioners assert that there is no basis for issuing a Notice of Abandonment. Petitioners contend that the examiner should have issued a Notice of Allowance stating that claims 154-156 stand allowed.

As previously stated, the Board's decision of April 20, 2007, presented new grounds of rejection for claims 89-156. On June 25, 2007 (certificate of mailing dated June 20, 2007), petitioners timely submitted a request for rehearing. In the decision of November 20, 2007, the Board withdrew the new grounds of rejection for claims 154-156. Thus, only claims 154-156 stand allowed. In accordance with MPEP 1214.06(II) and (IV), petitioners were not required to file a reply. Rather, the examiner should have canceled rejected claims 89-153 and issued the application with claims 154-156.

In view of the above, the Office concurs with petitioners that the Notice of Abandonment was mailed in error. The petition under 37 CFR 1.181 is **GRANTED**. The holding of abandonment is hereby withdrawn and the application is restored to pending status.

The application will be forwarded to Technology Center AU 1639 for appropriate action consistent with this decision.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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